

PTO/SB/21 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/495,982	
	Filing Date	02/01/2000	
	First Named Inventor	JONES, Christopher L.	
	Art Unit	3629	
	Examiner Name	DIXON, Thomas A.	
Total Number of Pages in This Submission	87	Attorney Docket Number	59036-249728

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): (1) Two additional copies of Substitute Appeal Brief; and 2) Return receipt postcard
Remarks		A COURTESY COPY of pg. 19 indicating our deposit account is enclosed in the event there is a charge for the enclosed Substitute Appeal Brief.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Michael A. DeSanctis, Reg. No. 39,957 Faegre & Benson LLP
Signature	
Date	September 18, 2003

RECEIVED
SEP 25 2003
GROUP 3600

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	Denise E. Voris	Date	September 18, 2003
Signature		Date	September 18, 2003

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual; case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Our Docket No. 59036-249728

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Christopher L. Jones et al.

Application No: 09/495,982

Filed: February 1, 2000

For: FINANCIAL ADVISORY SYSTEM

Examiner: Dixon, Thomas A.

Art Unit: 3629

Confirmation No.: 5534

RECEIVED

SEP 25 2003

GROUP 3600

SUBSTITUTE APPEAL BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Sir:

Applicant (hereafter "Appellant") hereby submits this Substitute Appeal Brief in triplicate in support of its appeal from a decision by the Examiner, mailed March 5, 2003, in the above-captioned application. Appellant respectfully requests consideration of this Appeal by the Board of Patent Appeals and Interferences (the "Board") for allowance of the above-captioned patent application.

On September 4, 2003, the Appellant filed a Notice of Appeal (via facsimile) for the present application which includes claims that have now been twice rejected by the Examiner. On September 5, 2003, the Appellant filed an Appeal Brief (via first class mail) and upon learning that the Examiner had not yet received a copy of the Appeal Brief, the Appellant provided a courtesy copy to the Examiner for his review on September 12, 2003 (via facsimile).

Therefore, this is a proper Appeal and Appellant's Substitute Appeal Brief ("Substitute Brief") in support of this Appeal follows.

Statement of the Substance of Telephonic Interview of September 16, 2003:

As an initial matter pursuant to the *Manual of Patent Examining Procedure* § 713.04 (8th ed., rev. 1, 2003) (hereinafter "MPEP"), the Appellant will now provide a statement of the substance of a telephonic interview conducted between Examiner Thomas A. Dixon and the undersigned on September 16, 2003 which prompted the filing of this Substitute Brief.

During the telephonic interview, the Examiner indicated he had briefly reviewed the Appeal Brief and expressed his opinion and that of his supervisor that the restriction requirement issue (Appeal Brief, pg. 8, Issue A) was not a proper issue for appeal to the Board. The Appellant is in agreement and therefore submits this Substitute Brief to exclude such restriction requirement issue and the claims involved therewith.

Statement of the Substance of Telephonic Interview of July 8, 2003:

Pursuant to *MPEP* § 713.04 and as requested by the Examiner in his Interview Summary mailed July 10, 2003, the Appellant will now provide a statement of the substance of a telephonic interview conducted among Examiner Thomas A. Dixon, Jason Scott, and the undersigned on July 8, 2003.

In an attempt to provide the Examiner with some context and understanding of the practical applications of various embodiments of the present invention, Mr. Scott and the undersigned began the telephone interview by providing an overview regarding the Financial Engines Investment Advisor® Service (available at: www.financialengines.com) which

represents a highly successful¹ commercial service that embodies various aspects of the present invention. Mr. Scott and the undersigned explained that the Financial Engines Investment Advisor Service helps investors select among investment products/funds that are available to them via their respective 401(k), IRA, or other investment accounts, for example. Consequently, the service makes recommendations that are personalized and constrained by the financial products capable of being purchased by the individual investor to whom the recommendation is directed. Mr. Scott and the undersigned emphasized the difference between creating an investment product or an investment fund having broad applicability/appeal and offering personalized investment advice regarding optimization of a particular investor's portfolio.

The discussion then turned specifically to the teaching of US Patent No. 5,812,987 of Luskin et al. ("Luskin"). Mr. Scott and the undersigned explained that the disclosure of Luskin is generally directed to *creating and managing an investment fund* (e.g., a lifestyle fund) that represents an investment product *intended for a class of individuals* presumably having similar investment horizons. In contrast, the methods and systems of the pending claims require identification of a *recommended portfolio for a particular investor* (see, e.g., last element of claim 1). Mr. Scott and the undersigned pointed out several passages in Luskin to support this interpretation of Luskin's teachings, including the following:

- "An invention for managing assets in one or more investment funds" (see Abstract);
- "A time horizon H_i is associated with each [investment] fund F_n " (see Summary);
- "The investment mix of a[n] [investment] fund is strategically adjusted at periodic intervals..." (see Summary);
- "The present invention is a system and method for managing assets in investment funds wherein each fund has a fixed time horizon"(Col. 3, lines 33-35); and
- "The risk R of a fund F_n provides individual investors with information about the fund to assist tailoring their investments in accordance with their own risk

¹ Fifteen financial institutions and 900 plan sponsors have hired Financial Engines to make advice available to over 3.2 million individuals.

preferences” (suggesting investors should perform manual tailoring of their investments for their needs – see Col. 4, lines 14-17).

Mr. Scott and the undersigned also explained to the Examiner that Figure 6 of Luskin relates to adjusting the investment mix of an investment fund based on the length to its horizon (i.e., step 522 of Figure 5).

Mr. Scott and the undersigned pointed out that a goal of the proposed Luskin methodology is to create an investment fund that will be widely acceptable (e.g., tailored for a class of individuals) (see Col. 7, line 55-58: “Optimizers 900 typically also include an upper bound, which represents a maximum exposure that *any* investor wishes to have to one or more asset classes or portfolios.” (emphasis added)).

Mr. Scott and the undersigned then explained the mapping / exposure analysis recited by the claims and described why Luskin has no need for such a mapping. Notably, it was pointed out by Mr. Scott and the undersigned that since Luskin’s approach creates a fund from scratch and assumes investments can be made directly in various asset classes, Luskin has no constraints with respect to financial products and their availability to particular investors. Rather, Luskin purports to be able to create particular levels of exposure of its investment funds to particular asset classes, such as “MSCI EAFE x-Japan” (see Table 1 at Col. 8) by simply purchasing the asset classes directly in appropriate quantities to obtain the desired exposures. In contrast, the methods and systems of the present invention are limited to identification of a recommended portfolio of financial products that are “available” to the particular investor to whom the financial advice to be rendered pertains. Consequently, the methods and systems of the present invention *indirectly* create exposures to particular asset classes by way of the available financial products; and hence the existence of the exposure analysis to create a mapping from the financial product returns domain to the asset class returns domain.

Mr. Scott and the undersigned summarized the differences between the teachings of Luskin and the mapping process used by the claims by explaining Luskin is composing a lifestyle fund based upon a desired asset class mix while the mapping process of claim 1, for example, essentially decomposes available financial products to allow them to be characterized in terms of asset class exposures and to allow expected returns of various portfolios of the available financial products to be determined based upon the characterization.

Mr. Scott and the undersigned reviewed the main points of distinction over Luskin by walking the Examiner through at least the following elements of claim 1 thought be clearly lacking from and not reasonably suggested by the teachings of Luskin: i) “*creating a mapping from* each financial product of an available set of *financial products onto* one or more assets classes of the plurality of *asset classes by determining exposures of the available set of financial products to each asset class*” (emphasis added); ii) “*determining expected returns* and volatility of returns *for each of a plurality of portfolios* [of financial products] on the efficient frontier *based upon the mapping*” (emphasis added); and iii) “*identifying a recommended portfolio* [of financial products] ...that maximizes an expected utility of wealth *for a particular investor*” (emphasis added).

Much to the dismay of Mr. Scott and the undersigned and despite the compelling arguments for patentability over Luskin put forth by Mr. Scott and the undersigned, the Examiner indicated his intent to stand by the strained logic of his prior two rejections. The Examiner then inquired of the undersigned why the interview did not address his 35 U.S.C. § 101 rejection. When the Examiner was told the non-statutory subject matter rejection was not thought to be supported by current Federal Circuit precedent, he responded by pointing out that the Examiners were in the process of receiving additional training on this topic, but that his

opinion was that recitation of specific hardware elements, such as processors and memories, would be required to overcome the non-statutory subject matter rejection.

While the undersigned's initial plan was to simply acquiesce to the Examiner's erroneous statutory subject matter analysis by submitting amended claims reciting processors and memories, equally unsupported positions with respect to 35 U.S.C. §§ 101, 112 and 120 were recently taken by the Examiner in a related pending application of the assignee. In view of the perceived pattern of unnecessary prosecution delays, the Appellant feels compelled to have these issues brought to the attention of and finally resolved by the Board.

REAL PARTY IN INTEREST

The real party in interest in this Appeal is Financial Engines, Inc., the assignee of all rights to the invention disclosed in the present application. The assignment of the inventors' rights to Financial Engines, Inc. was recorded in the United States Patent and Trademark Office on November 14, 2000, at Reel 011311, Frame 0660.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences related to this Appeal.

STATUS OF CLAIMS

Claims 1-57 are currently pending in the above-referenced application. In the second Office action mailed March 5, 2003 (the "**Second Office Action**"), the Examiner (1) indicated claims 34-57 were subject to restriction requirement and withdrew them from consideration; (2) introduced for the first time a rejection of claims 1-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; (3) rejected claims 1-3, 5-8, 10, 14-16, 18-21, 23-25, 27-33 for a

second time under 35 U.S.C. §102(e) as being anticipated by Luskin; (4) rejected claims 4, 17 and 26 under 35 U.S.C. §103(a) as being unpatentable over Luskin in view of US Patent No. 5,848,287 of Edesess (“Edesess”); (5) rejected claims 9 and 22 under 35 U.S.C. §103(a) as being unpatentable over Luskin in view of US Patent No. 5,644,727 of Atkins (“Atkins”); and (6) indicated claims 11-13 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 101 and to include all of the limitations of the base claim and any intervening claims.

Claims 1-33 as set forth in the Amendment and Response to Office Action mailed December 27, 2002, are the subject of this Appeal. The Appendix of Claims below sets forth a copy of the appealed claims.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the Examiner’s Second Office Action which rejected claims 1-10 and 14-33; and withdrew from consideration claims 34-57 as being directed to an invention purportedly independent or distinct from the invention originally claimed. A copy of all claims on appeal is attached hereto in the Appendix of Claims.

SUMMARY OF INVENTION

The systems and methods described and claimed in the above-referenced application generally relate to financial advisory services and seek to provide advice to an investor (directly or indirectly through a financial advisor) regarding feasible and optimal portfolio allocations among financial products available to the investor to achieve certain financial goals, such as a particular retirement standard of living, accumulating a down payment for the purchase of a

house, or saving enough money to send a child to college. (Spec. pg. 1, lines 16-18; and pg. 8, lines 18-23).

Unlike prior art “retirement calculators,” which require the end user to provide estimates of future inflation, interest rates and the expected return on investments, embodiments of the present invention model fundamental economic and financial forces. (Spec. pg. 2, lines 11-13; and pg. 7, line 13). Furthermore, unlike prior art programs that simply provide generic asset-allocation suggestions (typically in the form of a pie chart) that may or may not be attainable by a particular investor, embodiments of the present invention perform a portfolio optimization process (Fig. 3 reference numeral 340 and Fig. 7 reference numeral 750) to provide a recommended portfolio of financial products that are available to the investor. (Spec. pg. 2, lines 3-4; pg. 7, lines 8-12; and pg. 13, lines 23-25).

According to one embodiment, a factor model, implemented by the factor module 310, enables an assessment of how financial products and portfolios of financial products will respond to changes in returns of asset classes (a.k.a. factors) (see, e.g., Table 1, pg. 17) to which they are exposed. Return scenarios may be generated for each asset class of the factor model based upon future scenarios of one or more economic factors (e.g., price inflation, short-term interest rates, and dividend growth) (Spec. pg. 16, lines 2-6 and 21-26). Based on exposures of each financial product available to a particular investor to one or more of the asset classes of the factor model, a mapping may be created (e.g., a relationship identified) between the financial products and the factor model. In one embodiment, exposures of financial products to the factors is determined by returns-based style analysis. (Spec. pg. 18, line 21 to pg. 19, line 5; and EQ #4 on pg. 29). Given this relationship between the behavior of financial product returns relative to the returns of the factors, feasible investment scenarios may be generated and optimal portfolios may be

recommended based upon the investor's expressed or implied utility function, including risk tolerance, investment horizon, and/or savings rate decisions. (Spec. pg. 7, lines 13-23; pg. 8, lines 1-18; pg. 12, lines 10-23; and pg. 33, lines 7-24).

ISSUES

- A. Did the Examiner improperly reject claims 1-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter based on a long rejected standard requiring use or manipulation of an apparatus rather than using the standards articulated by the *MPEP* (e.g., at § 2106(IV)(B)(2)(b)(ii)) and modern Federal Circuit case law, such as *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999) and *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1374-75, 47 USPQ2d 1596, 1602 (Fed.Cir.1998), *cert. denied*, 525 U.S. 1093, 119 S.Ct. 851, 142 L.Ed.2d 704 (1999)?
- B. Did the Examiner improperly reject claims 1-3, 5-8, 10, 14-16, 18-21, 23-25 and 27-33 under 35 U.S.C. § 102(e) by attributing capabilities and functionality to Luskin clearly unsupported by and outside of the scope and contemplation of its written description?
- C. Did the Examiner improperly reject claims 4, 17 and 26 under 35 U.S.C. 103(a) in view of the deficiencies of the primary reference, Luskin?
- D. Did the Examiner improperly reject claims 9 and 22 under 35 U.S.C. 103(a) in view of the deficiencies of the primary reference, Luskin?

GROUPING OF CLAIMS

In view of the issues presented and for purposes of this Appeal, claims 1-33 stand or fall together.

ARGUMENT

A. The Examiner Applied a Long Rejected Standard in Making his Non-Statutory Subject Matter Rejection of Claims 1-30.

In the Second Office Action, the Examiner improperly rejected claims 1-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Appellant respectfully disagrees with the Examiner's statutory subject matter analysis and requests the Board to reverse the Examiner's mistaken conclusions in this regard as claims 1-30 are directed toward statutory subject matter and meet the Federal Circuit's definition of a "statutory process" under its currently propounded 35 U.S.C. § 101 analysis in, *inter alia*, *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999).

The Federal Circuit in *AT&T* indicated a "claim is limited to a practical application [in the technological arts] when the method as claimed produce[s] ***a concrete, tangible and useful result.***" *Id* at 1358 (emphasis added). Rather than applying this standard, the Examiner appears to have rejected claims 1-30 on the long discredited theory that a statutory process requires an apparatus to be used or manipulated. Notably, the Federal Circuit rejected a similar position in *AT&T*, where the alleged infringer argued that "method claims containing mathematical algorithms are patentable subject matter only if there is a 'physical transformation' or conversion of subject matter from one state into another." *Id*. The court reasoned that "[t]he notion of 'physical transformation' can be misunderstood. In the first place, it is not an invariable requirement, but merely one example of how a mathematical algorithm may bring about a useful application." *Id*. The court reiterated its finding from *Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 958 F.2d 1053 (Fed. Cir. 1992): "that the claimed process 'transformed' data

from one ‘form’ to another simply confirmed that Arrhythmia’s method claims satisfied § 101 because the mathematical algorithm included within the process was applied to *produce a number which had specific meaning – a useful, concrete, tangible result – not a mathematical abstraction.*” *AT&T Corp.*, 172 F.3d at 1359 (emphasis added).

With respect to the Examiner’s statement that “the method could be performed by the analysis of the human brain and utilizing word of mouth to identify the recommended portfolio,” the Appellant respectfully disagrees. Even a cursory review of the present application should have revealed to the Examiner that the subject matter sought to be patented is a useful process involving a programmed computer (see pg. 9, lines 3-9; and Figure 2) and having practical application at least in the context of a financial advisory system (see, e.g., pg. 9, lines 21-25; pg. 10, lines 2-7; pg. 15, lines 10-21; and Figures 1, 2, and 3). It is respectfully submitted that the methods recited by claims 1-30 do not merely manipulate an abstract idea or perform a purely mathematical algorithm; instead, they have real world value in connection with providing financial advisory services and the like and “produce a useful, concrete, tangible result.” See *AT&T Corp.*, 172 F.3d at 1359; *MPEP* § 2106(IV)(B)(2)(b)(ii). For example, the method of independent claim 1 includes “generating return scenarios for ... a plurality of asset classes ...; creating a mapping from ... [available] financial products onto ... asset classes ... by determining exposures ...; determining expected returns ... of a plurality of portfolios ... based upon the mapping; and identifying a recommended portfolio ... for a particular investor.” Although no apparatus is specifically recited by claim 1, no apparatus is necessary as claim 1 describes a computer-related process limited to a practical application in the technological arts. See *MPEP* § 2106(IV)(B)(2)(b)(ii). In claim 1, the recited “recommended portfolio” is clearly analogous to a “number which has a specific meaning – a useful, concrete, tangible result.” See

AT&T Corp., 172 F.3d at 1359. The recited “recommended portfolio” has a specific meaning and represents a useful, concrete and tangible result. Among other things, it provides the particular investor and/or his/her financial advisor, for example, with useful and meaningful information that allows specific and actionable investment decisions to be made in the context of the financial products available to the particular investor.

Similarly, independent claim 14 recites “a pricing kernel step for generating return scenarios for ... asset classes ...; a returns-based style analysis step for creating a mapping from ... [available] financial products onto ... asset classes ... by determining exposures ...; a step for determining expected returns ... of a plurality of portfolios ... based upon the mapping; and a recommendation step for identifying a recommended portfolio ... for a particular investor.” Independent claim 23 requires “estimating returns for ... [available] financial products ...; determining expected returns ... of a plurality of portfolios ...; and identifying a recommended portfolio ... that maximizes a particular investor’s utility function. ...”

These claim excerpts, though not the only evidence of compliance with 35 U.S.C. § 101, demonstrate that the methods recited by claims 1-30 qualify as statutory processes. The claimed statutory processes of claims 1-30 unquestionably perform steps beyond mere abstract idea manipulation and describe computer-related processes having practical application as evidenced by the useful, concrete and tangible result produced in the form of a recommended portfolio that assists an investor or his/her advisor in making investment decisions relating to allocation of wealth among available financial products. Consequently, it should be abundantly clear that the recited methods satisfy the standard for statutory subject matter articulated by modern case law and the “Examination Guidelines for Computer-Related Inventions” set forth in *MPEP* § 2106. For at least these reasons, the methods recited by claims 1-30 satisfy the appropriate standard for

statutory processes under 35 U.S.C. § 101. Therefore, the Appellant respectfully requests the Board to reverse the Examiner's faulty 35 U.S.C. § 101 rejection of claims 1-30.

B. The Examiner Improperly Rejected Claims 1-3; 5-8, 10, 14-16, 18-21, 23-25 and 27-33 under 35 U.S.C. § 102(e) by Attributing to Luskin Functionality that is Neither Required, Taught, nor Reasonably Suggested by the Disclosure of Luskin.

The Examiner incorrectly rejected claims 1-3, 5-8, 10, 14-16, 18-21, 23-25 and 27-33 under 35 U.S.C. § 102(e) as being anticipated by Luskin. "A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference." *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). Applying this standard for anticipation reveals that the Luskin reference has been misunderstood, mischaracterized and/or misapplied by the Examiner. Careful analysis illustrates Luskin does not disclose each and every limitation expressly recited and required by the claims.

As presently understood by the undersigned, Luskin generally relates to an *investment fund* management method (see Title and Abstract). In managing an investment fund for a particular class of investors (e.g., those having a common horizon), Luskin teaches the investment mix of the fund among asset classes (see Table 1 in Col. 8) is adjusted (see 522 of Figure 5) as a function of a predetermined risk profile which assumes decreased risk tolerance as the length to the horizon decreases (see Col. 6, lines 33-46). Importantly, Luskin makes changes in the investment mix of the investment fund by physically purchasing or disposing of such asset classes directly (see Col. 8, lines 10-19). Such a situation significantly simplifies the task of portfolio optimization as when it is determined to be desirable to achieve particular exposure

levels to particular asset classes, the assumption in Luskin is that one simply and conveniently purchases and/or disposes of an appropriate amount of such asset classes to achieve the desired exposures. Notably, this highly simplified scenario is neither practical nor useful when rendering personalized financial advice for a particular investor. Consequently, Luskin's simplified investment fund management environment is far removed from and nonanalogous to the context of the present invention in which portfolio recommendations are constrained to allocation of wealth among a plurality of financial products that are available to a particular investor.

Luskin does not contemplate and has no need for exposure analysis. As a result of the simplifying assumptions made by Luskin (e.g., no constraints on investments available for purchase/sale to build/reallocate the investment fund), Luskin has no need for performing exposure analysis (e.g., creating a mapping between returns of the financial products available to a particular investor and returns of a plurality of asset classes).

Luskin creates and manages "lifestyle funds" and advocates is a one-size-fits-all, simplified investment vehicle for investors having similar time horizons rather than an individualized portfolio optimization approach as provided by various embodiments of the present invention. ***Luskin's suggested approach is the antithesis of personalized investment advice.*** Rather than evaluating financial products (e.g., stocks, bonds, mutual funds, etc.) available to a particular investor (e.g., via an employer sponsored 401(k) plan) and identifying a recommended portfolio of such available financial products for the particular investor, Luskin suggests that investors should invest in an off-the-rack investment fund that is designed to be widely acceptable to a broad class of investors that are assumed to have similar risk profiles as a

result of their common investment horizons (even though their financial goals, savings rates, and true risk tolerances may vary considerably).

As evidenced by the prosecution history, the Examiner has incorrectly attributed functionality to Luskin that is clearly absent from the disclosure of Luskin. The Examiner then proceeded to use such attributed functionality to find anticipation under 35 U.S.C. § 102(e). For example, in the Second Office Action, the Examiner reiterated his mistaken belief that Luskin teaches “creating a mapping from each financial product of an available set of financial products onto one or more assets classes of the plurality of asset classes by determining exposures of the available set of financial products to each asset class” citing “Figure 6 (900) and column 7, line 47 – column 8, line 7.” Notably, the item bearing reference numeral 900 in Figure 6 of Luskin is a box labeled “Optimize Portfolio.” Meanwhile the portion of the written description of Luskin cited to support the Examiner’s conclusion is equally deficient in terms of teaching or suggestion regarding the recited exposure analysis. As far as the undersigned can comprehend, the only plausible explanation for the Examiner’s reliance on the above-noted portion of Luskin in relation to the recited exposure analysis is the existence of the word “exposure” at Col. 7, lines 54 and 57. Presumably, the Examiner’s electronic search of prior art for certain key words included the word “exposure” as one of the search terms. In all other respects, this portion of Luskin is completely irrelevant and unrelated to the recited exposure analysis performed by claim 1. The use of the term “exposure” in this portion of Luskin is in connection with the notion of providing an upper or lower bound on the amount invested in any particular asset class so as to promote the wide acceptability of the resulting investment fund. Neither this portion of Luskin nor any other portion of Luskin contemplate, teach or reasonably suggest creating a mapping from each of a plurality of financial products that are available to a particular investor

onto one or more of a plurality of assets classes by determining exposures of the available financial products to each asset class. Again, such a discussion in the context of Luskin is superfluous in view of the simplifying assumptions made by Luskin. There is no need for the recited mapping when all the asset classes can be purchased directly and there are no constraints in terms of the available financial products for building an investment fund. For at least this reason, claim 1 and its dependents are thought to be distinguishable over Luskin.

Similar problems exist with respect to the Examiner's conclusion that Luskin discloses "*determining expected returns and volatility of returns for each of a plurality of portfolios* [of financial products] on the efficient frontier *based upon the mapping*" (Emphasis Added. See claim 1). As illustrated above, Luskin does not teach or reasonably suggest the mapping. It necessarily follows that Luskin cannot determine expected returns of portfolios based on such mapping. Turning to the Examiner's alleged support for this element in Luskin, the Examiner points to "column 4, lines 26-43 and column 9, line 22 – column 10, line 30 and figures 5A-D" of Luskin. Again, there is no recognizable basis for application of the cited portions to the claim element at issue. Sadly, again, it appears reliance on a key word search and a lack of clear understanding of the portions relied upon caused this erroneous rejection. For example, various words in this claim element are present, such as a number of out-of-context occurrences of the terms "portfolio" and "portfolios" (see, e.g., Col. 4, lines 27, 32, 33, 37 and 43), "volatility" (see Col. 4, line 34-5), "expected return" (see, e.g., Col. 4, line 35). Meanwhile, the relevance of Figures 5A-D is unknown as they purport to depict the shift of risk tolerance over time for an investment fund. Similarly, Col. 9, line 22 to Col. 10, line 30 of Luskin, as above, includes some out-of-context usage of various terms in the recited element, such as "efficient frontier" (Col. 10, lines 22 and 23), but the Examiner's proposed application of the relied upon portion is unclear.

In this latter portion of Luskin, all that is suggested is a conventional mean/variance optimization process involving multiple asset classes. Any further relevance escapes the undersigned. For at least this additional reason, claim 1 and its dependents are thought to be allowable over Luskin.

A further deficiency of the Luskin reference is in connection with the recited element of “*identifying a recommended portfolio* of the plurality of efficient portfolios that maximizes an expected utility of wealth *for a particular investor*” (Emphasis Added. See claim 1). As explained above, Luskin teaches creation of a widely acceptable investment fund that is not personalized or optimized for any investor; instead the investment fund is optimized for a particular time horizon and its underlying asset mix is dynamically adjusted based upon an assumed risk tolerance profile that is tied to the remaining life of the investment fund. For at least this further reason, claim 1 and its dependents are thought to be patentable over the teachings of Luskin.

As illustrated above with respect to claims 14 and 23 and as is apparent from a cursory review of claims 31-33, these remaining independent claims contain limitations similar to those discussed with reference to claim 1. For at least this reason, all the independent claims and their respective dependent claims are also thought to be allowable over Luskin.

C. Since Edesess Does Not Address the Deficiencies of Luskin Noted Above with Reference to Claim 1, the Combination of Luskin and Edesess is Deficient in the Same Regard.

The Examiner improperly rejected claims 4, 17 and 26 under 35 U.S.C § 103(a) as being unpatentable over Luskin in view of Edesess. The Examiner relies on Edesess solely for allegedly teaching that “mean-variance optimization is an old and well known alternative for portfolio optimization.” There is no need to address the correctness of the Examiner’s assertion

as the truth or falsity has no bearing on the relevance of the combination of Luskin and Edesess to the independent claims. Specifically, there is no teaching or suggestion in Edesess that addresses the deficiencies of Luskin pointed out above with respect to claim 1. Consequently, combining Edesess with Luskin provides no additional support for the Examiner's rejection thereby leaving the combination equally deficient with respect to the independent claims. For at least this reason, claims 1-33 are distinguishable over the combination of Luskin and Edesess.

D. Since Atkins Does Not Address the Deficiencies of Luskin Noted Above with Reference to Claim 1, the Combination of Luskin and Atkins is Deficient in the Same Regard.

The Examiner improperly rejected claims 9 and 22 under 35 U.S.C § 103(a) as being unpatentable over Luskin in view of Atkins. The Examiner relies on Atkins solely for allegedly teaching "a stochastic process." There is no need to address the correctness of the Examiner's assertion as the truth or falsity has no bearing on the relevance of the combination of Luskin and Atkins to the independent claims. Specifically, there is no teaching or suggestion in Atkins that addresses the deficiencies of Luskin pointed out above with respect to claim 1. Consequently, combining Atkins with Luskin provides no additional support for the Examiner's rejection thereby leaving the combination equally deficient with respect to the independent claims. For at least this reason, claims 1-33 are distinguishable over the combination of Luskin and Atkins

CONCLUSION

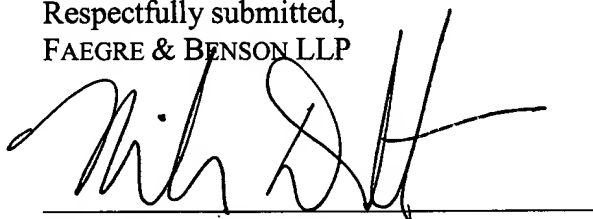
The Examiner improperly rejected claims 1-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter based on a long rejected standard requiring use or manipulation of an apparatus that is clearly at odds with current Federal Circuit precedent.

The combination of references relied upon by the Examiner (i.e., Luskin, Edesess and Atkins) do not individually or collectively teach or reasonably suggest at least three claim elements. The Examiner improperly attributed functionality to Luskin that is unsupported by, inconsistent with and outside the scope of the written description of Luskin. Meanwhile, neither Edesess nor Atkins address the deficiencies noted with respect to Luskin thereby leaving any combination equally lacking. For the aforementioned reasons, the Examiner's rejections should be reversed, and claims 1-33 should be allowed.

FEES

To the extent any additional fee is required for the filing and consideration of this Substitute Brief, the Commissioner is authorized to charge our Deposit Account No. 06-0029 and requested to notify us of same.

Respectfully submitted,
FAEGRE & BENSON LLP



Michael A. DeSanctis
Reg. No. 39,957

Date: September 18, 2003

3200 Wells Fargo Center
1700 Lincoln Street
Denver, CO 80203
(303) 607-3633

DNVR1:60242752.01

Docket No.: 59036-249728
Application No.: 09/495,982

APPENDIX OF CLAIMS
37 C.F.R. § 1.192(c)(9)

The claims on appeal read as follows:

1 1. A method comprising:

2 generating return scenarios for each asset class of a plurality of asset classes based
3 upon future scenarios of one or more economic factors;

4 creating a mapping from each financial product of an available set of financial
5 products onto one or more asset classes of the plurality of asset classes by determining
6 exposures of the available set of financial products to each asset class of the plurality of
7 asset classes;

8 determining expected returns and volatility of returns for each of a plurality of
9 portfolios on the efficient frontier based upon the mapping, each of the plurality of
10 portfolios including combinations of financial products from the available set of financial
11 products; and

12 identifying a recommended portfolio of the plurality of efficient portfolios that
13 maximizes an expected utility of wealth for a particular investor.

1 2. The method of claim 1, wherein the expected returns and the volatility of returns for each
2 of the plurality of portfolios on the efficient frontier are determined analytically.

1 3. The method of claim 1, wherein the expected returns and the volatility of returns for each
2 of the plurality of portfolios on the efficient frontier are determined based upon a
3 simulation process.

- 1 4. The method of claim 1, wherein the particular investor's utility function comprises a
2 mean-variance utility function.
- 1 5. The method of claim 1, wherein said identifying a recommended portfolio assumes a
2 constant-mix strategy.
- 1 6. The method of claim 1, wherein said identifying a recommended portfolio assumes a
2 buy-and-hold strategy.
- 1 7. The method of claim 1, wherein the available set of financial products represents a set of
2 financial products offered through an employee-directed defined contribution plan.
- 1 8. The method of claim 7, wherein the available set of financial products comprises one or
2 more of bonds, stocks, and mutual funds.
- 1 9. The method of claim 1, wherein said generating return scenarios for each asset class of a
2 plurality of asset classes employs a model that incorporates a stochastic process that
3 limits the prices on the assets and payoffs in such a way that no arbitrage is possible.
- 1 10. The method of claim 1, wherein the plurality of asset classes includes a core set of asset
2 classes and a set of factor asset classes, and wherein the method further includes
3 conditioning the factor asset classes upon the core asset classes.
- 1 11. The method of claim 10, wherein said conditioning the factor asset classes upon the core
2 asset classes employs the following equation:

3
$$r_{it} = \alpha_i + \beta_{1i}ST_Bonds_t + \beta_{2i}LT_Bonds_t + \beta_{3i}US_Stocks_t + \varepsilon_t$$

4 where,

5 r_{it} represents the return for a factor, i , at time t ,

6 β_{ji} represents the sensitivity of the factor i to core asset class j ,

7 ST_Bonds_t represents the returns estimated for short-term US government bonds at time

8 t ,

9 LT_Bonds_t represents the returns estimated for long-term US government bonds at time

10 t ,

11 US_Stocks_t represents the returns estimated for US stocks at time t ,

12 α_i is a constant representing the average returns of factor asset class i relative to core

13 asset class exposures, and

14 ε_i is a residual random variable.

1 12. The method of claim 11, further including imposing macroconsistency upon the factor
2 asset class returns by estimating α_i relative to a known efficient portfolio.

3 13. The method of claim 12, wherein said imposing macroconsistency upon the factor asset
4 class returns includes calibrating α_i to be consistent with observed market weightings of
5 the factor asset classes associated with the Market Portfolio.

1 14. A method comprising the steps of:

2 a pricing kernel step for generating return scenarios for each asset class of a
3 plurality of asset classes based upon future scenarios of one or more economic factors;
4 a returns-based style analysis step for creating a mapping from each financial
5 product of an available set of financial products onto one or more asset classes of the

6 plurality of asset classes by determining exposures of the available set of financial
7 products to each asset class of the plurality of asset classes;

8 a step for determining expected returns and volatility of returns for each of a
9 plurality of portfolios on the efficient frontier based upon the mapping, each of the
10 plurality of portfolios including combinations of financial products from the available set
11 of financial products; and

12 a recommendation step for identifying a recommended portfolio of the plurality of
13 efficient portfolios that maximizes an expected utility of wealth for a particular investor.

1 15. The method of claim 14, wherein the expected returns and the volatility of returns for
2 each of the plurality of portfolios on the efficient frontier are determined analytically.

1 16. The method of claim 14, wherein the expected returns and the volatility of returns for
2 each of the plurality of portfolios on the efficient frontier are determined based upon a
3 simulation process.

1 17. The method of claim 14, wherein the particular investor's utility function comprises a
2 mean-variance utility function.

1 18. The method of claim 14, wherein said recommendation step assumes a constant-mix
2 strategy.

1 19. The method of claim 14, wherein said recommendation step assumes a buy-and-hold
2 strategy.

1 20. The method of claim 14, wherein the available set of financial products represents a set of
2 financial products offered through an employee-directed defined contribution plan.

1 21. The method of claim 20, wherein the available set of financial products comprises one or
2 more of bonds, stocks, and mutual funds.

1 22. The method of claim 14, wherein said pricing kernel step employs a model that
2 incorporates a stochastic process that limits the prices on the assets and payoffs in such a
3 way that no arbitrage is possible.

1 23. A method comprising:

2 estimating returns for each financial product of an available set of financial
3 products based upon the financial product's sensitivity to movements of a plurality of
4 predetermined economic factors by utilizing a factor model;

5 determining expected returns and volatility of returns for each of a plurality of
6 portfolios on the efficient frontier for the available set of financial products, the plurality
7 of portfolios each including one or more financial products of the available set of
8 financial products; and

9 identifying a recommended portfolio of the plurality of portfolios that maximizes
10 a particular investor's utility function at a predetermined time horizon taking into
11 consideration the timing and amount of expected contributions and expected withdrawals,
12 if any.

1 24. The method of claim 23, wherein the expected returns and the volatility of returns for
2 each of the plurality of portfolios on the efficient frontier are determined analytically.

- 1 25. The method of claim 23, wherein the expected returns and the volatility of returns for
2 each of the plurality of portfolios on the efficient frontier are determined based upon a
3 simulation process.
- 1 26. The method of claim 23, wherein the utility function comprises a mean-variance utility
2 function.
- 1 27. The method of claim 23, wherein said identifying a recommended portfolio assumes a
2 constant-mix strategy.
- 1 28. The method of claim 23, wherein said identifying a recommended portfolio assumes a
2 buy-and-hold strategy.
- 1 29. The method of claim 23, wherein the available set of financial products represents a set of
2 financial products offered through an employee-directed defined contribution plan.
- 1 30. The method of claim 29, wherein the available set of financial products comprises one or
2 more of bonds, stocks, and mutual funds.
- 1 31. A financial advisory system comprising:
2 a forecasting means for generating return scenarios for each asset class of a
3 plurality of asset classes based upon future scenarios of one or more economic factors;
4 a fund decomposition means, communicatively coupled to the forecasting means,
5 for creating a mapping from each financial product of an available set of financial
6 products onto one or more asset classes of the plurality of asset classes by determining

7 exposures of the available set of financial products to each asset class of the plurality of
8 asset classes;

9 a means, communicatively coupled to both the forecasting means and the fund
10 decomposition means, for determining expected returns and volatility of returns for each
11 of a plurality of portfolios on the efficient frontier based upon the mapping, each of the
12 plurality of portfolios including combinations of financial products from the available set
13 of financial products; and

14 a portfolio optimization means for identifying a recommended portfolio of the
15 plurality of efficient portfolios that maximizes an expected utility of wealth for a
16 particular investor based on the expected returns and the volatility of returns.

1 32. A computer system comprising:

2 a storage device having stored therein a portfolio optimization routine to
3 determine portfolio return scenarios for one or more portfolios including combinations of
4 financial products from an available set of financial products and identify a recommended
5 portfolio;

6 a processor coupled to the storage device to execute the portfolio optimization
7 routine to generate asset class return scenarios, a mapping, portfolio return scenarios, and
8 identify the recommended portfolio, where:

9 the asset class return scenarios are generated for each asset class of
10 a plurality of asset classes based upon future scenarios of one or more
11 economic factors;

12 the mapping associates each financial product of the available set
13 of financial products with one or more asset classes of the plurality of

14 asset classes, the mapping is generated by determining exposures of the
15 available set of financial products to each asset class of the plurality of
16 asset classes;
17 the portfolio return scenarios are generated by determining
18 expected returns and volatility of returns for each of a plurality of
19 portfolios on the efficient frontier based upon the mapping, each of the
20 plurality of portfolios including combinations of financial products from
21 the available set of financial products; and
22 the recommended portfolio is identified by determining a portfolio
23 of the plurality of efficient portfolios that maximizes an expected utility of
24 wealth for a particular investor.

1 33. A machine-readable medium having stored thereon data representing sequences of
2 instructions, said sequences of instructions which, when executed by a processor, cause
3 said processor to:
4 estimate returns for each financial product of an available set of financial products
5 based upon the financial product's sensitivity to movements of a plurality of
6 predetermined economic factors by utilizing a factor model;
7 determine expected returns and volatility of returns for each of a plurality of
8 portfolios on the efficient frontier for the available set of financial products, the plurality
9 of portfolios each including one or more financial products of the available set of
10 financial products; and
11 identify a recommended portfolio of the plurality of portfolios that maximizes a
12 particular investor's utility function at a predetermined time horizon taking into

13 consideration the timing and amount of expected contributions and expected withdrawals,
14 if any.